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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,682	07/31/2003	Chaitan Khosla	286002022900	2700
25225	7590	03/04/2005	EXAMINER	
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			SAIDHA, TEKCHAND	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/632,682

Applicant(s)

KHOSLA ET AL.

Examiner

Tekchand Saidha

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **desosamine** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.
- II. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **cladinose** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.
- III. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **mycaminose** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.
- IV. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **oleandrose** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.
- V. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **forosamine** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.
- VI. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **daunosamine** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.
- VII. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **mycarose** as the

diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.

VIII. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **ascarylose** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.

IX. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **rhamnose** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.

X. Claims 1-20 (all-in-part), drawn to a recombinant E. coli host cell containing an expression system for producing **mycosamine** as the diphosphate 6-deoxy-sugar , classified in class 435, subclass 252.33.

2. Each of the Inventions I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions pertain to E. coli host cells transformed with a different gene cluster for the production of a specific diphosphate 6-deoxy-sugar, as indicated in the respective groups. Therefore, each of the groups is distinct from the other not only in the host cell construct involving distinct gene cluster, but also in the sugar produced by the cell.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Carolyn A. Favorito on February 28, 2005, to request an oral election to the above restriction requirement, but did not result in an election being made.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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February 28, 2005